

Advisory Action
After the Filing of an Appeal Brief

Application No.	Applicant(s)	
09/878,860	MOCKRY ET AL.	
Examiner	Art Unit	
MIKE CHAMBERS	3711	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The reply filed 02 April 2008 is acknowledged.

1. ☐ The reply filed on or after the date of filing of an appeal brief, but prior to a final decision by the Board of Patent Appeals and Interferences, will not be entered because:

a. ☐ The amendment is not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).

b. ☐ The affidavit or other evidence is not timely filed before the filing of an appeal brief.
See 37 CFR 41.33(d)(2).

2. ☐ The reply is not entered because it was not filed within the two month time period set forth in 37 CFR 41.39(b), 41.50(a)(2), or 41.50(b) (whichever is appropriate). Extensions of time under 37 CFR 1.136(a) are not available.

Note: This paragraph is for a reply filed in response to one of the following: (a) an examiner's answer that includes a new ground of rejection (37 CFR 41.39(a)(2)); (b) a supplemental examiner's answer written in response to a remand by the Board of Patent Appeals and Interferences for further consideration of rejection (37 CFR 41.50(a)(2)); or (c) a Board of Patent Appeals and Interferences decision that includes a new ground of rejection (37 CFR 41.50(b)).

3. ☐ The reply is entered. An explanation of the status of the claims after entry is below or attached.

4. ☒ Other: Although the applicant has filed a new brief, the basic facts remain the same. The applicant is claiming a method that would not have been obvious to one of ordinary skill in the art. As noted prior to KSR, It appears the applicant believes one of ordinary skill in the art should wear "blinders" when combining prior art references. The CAFC has noted that this is not an appropriate view of one of ordinary skill in the art. In the CAFC decision on Sovish et al, the court took some pains to note what one of ordinary skill in the art would be aware of when combining references for an obviousness rejection.

In re Sovish, Moisson, and Selleslags (CAFC 226 USPQ 771 July 26, 1985, 85-781) the court found the argument that the propriety of combining the references was proper for one skilled in the art: The CAFC further noted in its decision on the plaintiff's claim of impropriety in combining references "This argument presumes stupidity rather than skill. The decision of the board is affirmed"

So too, it would have been obvious to one of ordinary skill in the art to have combined the references as noted. The recent Supreme Court Decision on KSR has further indicated that the TSM rational argued by the applicant is only one of several valid lines of reasoning in determining what is obvious to one of ordinary skill in the art.

Under KSR rationale – combining prior art elements according to known methods to yield predictable results is not patentable. As noted in ProQuest, the method of recording shortened baseball games was known prior to the instant application The full transcript of the ProQuest article is attached. As noted in the Examiner's answer, the method claimed is merely combining "old" well known ideas. The argument that others promotional ad material prove the idea is novel is not found persuasive. Hyperbolae is well known in the advertising arts. Although the ProQuest article does not clearly spell out the method claimed, the differences would be obvious variations.

/Gene Kim/
Supervisory Patent Examiner, Art Unit 3711

/Mike Chambers/